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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,544

Applicant(s)

LORENZ, RICHARD

Examiner

OLEG SURVILLO

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2008 and 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statements (PTO/SB/08)
Paper No(s)/Mail Date 01/18/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-30 remain pending in the application. Claims 1-4, 7, 9, 11, 13-21, 23, 24, 27, and 29 are currently amended. No claims have been canceled. No new claims have been added.

It is being noted that status identifier of claim 2 shows "Currently Amended". However, claim 2 has not been amended in the reply dated March 21, 2008. For the purposes of examination claim 2 will be treated as "Original". Applicant is required to verify the correctness of identifiers for all the claims in their next reply.

Response to Arguments

2. With regard to the Applicant's remarks dated March 21, 2008:

regarding a missing copy of one of the two foreign references, the Examiner thanks the Applicant for providing another copy of this references. Document WO 02/05464 is now considered and a copy of IDS dated 01/18/05 is attached with this Office action.

Regarding drawings objections, Applicant's arguments and amendments have been fully considered, and are sufficient with an exception of the objection at paragraph 4 of the last Office action that has not been obviated by amendments to Figs. 1-2. See section: Drawings, below.

Regarding objection to the abstract of the disclosure, Applicant's arguments and amendments have been fully considered, but they are not sufficient, as discussed below under the section: Specification.

Regarding objections to the disclosure, Applicant's amendments have been fully considered, and are sufficient with an exception of the objection to the Brief Summary of the Invention, as discussed below under the section: Specification.

Regarding claim objections, Applicant's amendments and arguments have been fully considered and are sufficient. Therefore, previously made claim objections have been withdrawn.

Regarding the rejection of claims 21-30 under 35 U.S.C. 101, Applicant's arguments and amendments have been fully considered, and are sufficient. Therefore, the rejection has been withdrawn at this time. However, Applicant is reminded that paragraph [0041] of the specification still refers to a machine usable medium as including signal bearing medium. See line 6. Therefore, Applicant is advised to amend par. [0041] to remove reference to a signal bearing medium.

Regarding the rejection of claims 1-9, 13-19, and 23-29 under 35 U.S.C. 112, second paragraph, Applicant's amendments and arguments have been fully considered and are sufficient. Therefore, previously made rejection has been withdrawn.

Regarding the rejection of claims 1-4, 11-14, and 21-24 under 35 U.S.C. 102(b) as being anticipated by Paul, Applicant's arguments have been fully considered, but they are not persuasive. Applicant argued regarding claim 1 that Paul does not teach or suggest the newly added limitation of *adding an address corresponding to a sender of*

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the electronic mail message to a list of valid senders if the email includes the intro-word.

This argument is not persuasive because Paul does teach this limitation, as discussed below under the section: Claim Rejections – 35 U.S.C. 102.

As to any arguments not specifically addressed, they are the same as discussed above.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: (100) that appears in the specification at par [0040] line 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because it repeats information given in the title. In particular, the first sentence of the abstract repeats the title verbatim. See MPEP 608.01(b) under GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS, section C. Language and Format.

6. Applicant is reminded of the proper summary of the invention. See MPEP § 608.01(d).

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. **Stereotyped general statements that would fit one application as well as another serve no useful purpose** and may well be required to be canceled as surplusage, and,

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in the absence of any illuminating statement, replaced by statements that are directly on point as applicable exclusively to the case at hand.

7. The Brief Summary of the Invention is objected to because it does not point out the advantages of the invention or how it solves problems previously existent in the prior art at paragraphs [0006]-[0007] of the disclosure. Therefore, the nature and gist of the invention or the inventive concept cannot be determined by USPTO personnel and the public when referring to these paragraphs. See 37 CFR 1.73.

8. The use of trademarks at paragraph [0018] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Applicant is requested to capitalize each letter of the word in the bracket or include a proper trademark symbol, such as [UNIX], [LINUX] or Unix®, Linux® following the word. See MPEP 608.01(v).

9. The specification is objected to under 37 CFR 1.75(d)(1) as failing to provide a clear support or antecedent basis in the description for claim 21. In particular, "a machine-**readable** medium" is not recited in the specification. Applicant is required to either amend par. [0041] of the specification to recite "machine **readable** medium"

instead of "machine **usable** medium" or amend claim 21 to use same terminology as in the specification.

Claim Objections

10. Claim 11 is objected to because of the following informalities: it is not clear where the preamble ends and the body begins. Applicant is required to clearly indicate where the preamble ends, such as by using a colon. For the purposes of examination, the preamble is interpreted to conclude with the word: "comprising".

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4, 10-14, 20-24, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Paul (US Patent No.: 5,999,932).

As to claim 1, Paul teaches:

receiving, in a data processing system, an electronic mail message (col. 8 lines 18-22, Fig. 4 element 401);

determining if the electronic mail message includes an intro-word [field data] (col. 8 lines 22-27, Fig. 4 elements 402 and 403);

if the electronic mail message includes the intro-word, then delivering the electronic mail message (col. 8 lines 27-31; Fig. 4 elements 410 and 415) and adding an address corresponding to a sender of the electronic mail message to a list of valid senders ["FROM" data from the received message is added to the corresponding category of data in the user inclusion list] (col. 8 lines 52-54, Fig. 4A element 411); and storing the electronic mail message if the electronic mail message is not delivered [storing all messages received by the system, which includes storing messages that are ultimately not delivered to the recipient] (col. 7 lines 17-20, Fig. 3).

As to claim 2, Paul shows that the intro-word is located in a subject line of the electronic mail message (col. 7 lines 31-33; col. 8 lines 47-49).

As to claim 3, Paul shows that the electronic mail message is also delivered if the email address of a sender of the electronic mail message is on an authorized sender list [if data in the "FROM" field of the incoming e-mail message matches the data stored in a corresponding field of the inclusion list, message is forwarded to the user] (col. 7 lines 29-36).

As to claim 4, Paul shows that the electronic mail message is also delivered if the domain name of a sender of the electronic mail message is on an authorized domain list (col. 9 lines 41-43).

As to claim 10, Paul shows deleting the stored electronic mail message after a predetermined amount of time [discarding the message that is not displayed at the conclusion of the heuristic processing] (col. 9 lines 4-7, Fig. 4 element 422).

As to claim 11, Paul shows a data processing system (col. 2 lines 48-58) comprising:

at least a processor [processor 201] (col. 2 lines 48-51, Fig. 2) and accessible memory [storage 202] (col. 2 lines 48-54, Fig. 2), the data processing system configured to perform the claimed functionality, as discussed per claim 1, above.

As to claim 12, Paul shows all the elements, as discussed per claim 2, above.

As to claim 13, Paul shows all the elements, as discussed per claim 3, above.

As to claim 14, Paul shows all the elements, as discussed per claim 4, above.

As to claim 20, Paul shows all the elements, as discussed per claim 10, above.

As to claim 21, Paul inherently shows instructions (col. 3 lines 23-25) for performing claimed functionality, as discussed per claim 1, above.

As to claim 22, Paul shows all the elements, as discussed per claim 2, above.

As to claim 23, Paul shows all the elements, as discussed per claim 3, above.

As to claim 24, Paul shows all the elements, as discussed per claim 4, above.

As to claim 30, Paul shows all the elements, as discussed per claim 10, above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5-9, 15-19, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Wilson (US 2004/0015554 A1).

As to claim 5, Paul shows all the elements, except for sending a confirmation message to the sender of the electronic mail message if the electronic mail message does not include the intro-word. (Paul shows that if the electronic mail message does not include the field data that would match the corresponding data in one of the categories of the inclusion list, then discarding the electronic mail message, at step 422 of Fig. 4).

Wilson shows if the electronic mail message does not include the intro-word [sender's address has not been previously approved] (par. [0053]-[0054], Fig. 2), then sending a confirmation message to the sender of the electronic mail message [challenge message] (par. [0054]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Paul by sending a confirmation message to the sender of the electronic mail message if the electronic mail message does not include

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the intro-word in order to verify that the electronic mail message was sent by a human (par. [0024] in Wilson).

As to claim 6, Paul in view of Wilson shows:

receiving a response mail message corresponding to the confirmation message (par. [0026] in Wilson);

delivering the electronic mail message if the response mail message includes the intro-word (par. [0026] in Wilson); and

storing the electronic mail message if the response mail message does not include the intro-word (col. 7 lines 17-20, Fig. 3 in Paul; par. [0054] lines 1-3 in Wilson).

As to claim 7, Paul in view of Wilson shows:

receiving a response corresponding to the confirmation message via an Internet connection (par. [0057], [0062] in Wilson);

delivering the electronic mail message if the response includes the intro-word (par. [0026] in Wilson); and

storing the electronic mail message if the response mail message does not include the intro-word (col. 7 lines 17-20, Fig. 3 in Paul; par. [0054] lines 1-3 in Wilson).

As to claim 8, Paul in view of Wilson shows:

sending an obscured image of the intro-word to the sender (par. [0079] in Wilson).

As to claim 9, Paul in view of Wilson shows sending the intro-word to the sender in a non-computer harvestable form (par. [0079] in Wilson).

As to claims 15 and 25, Paul in view of Wilson shows all the elements, as discussed per claim 5, above.

As to claims 16 and 26, Paul in view of Wilson shows all the elements, as discussed per claim 6, above.

As to claims 17 and 27, Paul in view of Wilson shows all the elements, as discussed per claim 7, above.

As to claims 18 and 28, Paul in view of Wilson shows all the elements, as discussed per claim 8, above.

As to claims 19 and 29, Paul in view of Wilson shows all the elements, as discussed per claim 9, above.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLEG SURVILLO whose telephone number is (571)272-9691. The examiner can normally be reached on M-Th 8:30am - 6:00pm; F 8:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner: Oleg Survillo

Phone: 571-272-9691

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142